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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,290	10/22/2001	Jay Wohlgemuth	506612000100	8497

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EXAMINER

SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,290

Applicant(s)

WOHLGEMUTH ET AL.

Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-72 is/are pending in the application.
- 4a) Of the above claim(s) 56-59 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55,60 and 66-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group V, claim 40, in the reply filed on 22 November 2005 is acknowledged. The traversal is on the ground(s) that it would not be an undue burden to search 10 sequences. This is not found persuasive because each sequence is considered a distinct invention, requiring separate searches. The aspect of having the Office to search such a number of sequences would place a burden on the office's resources.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 56-59 and 61-65 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 22 November 2006.

3. In view of the election of SEQ ID NO: 4758, claim 55 has been examined only to the extent that it reads on the elected sequences. All other sequences recited therein have not been examined as such are drawn to non-elected inventions.

Specification

4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded

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hyperlink and/or other form of browser-executable code; see for example, pages 110-119, 121, 153, 154, and 343-345. See MPEP § 608.01.

5. The disclosure is objected to because of the following informalities: The papers that have been scanned in do not contain the entire Sequence Listing. The Sequence Listing (paper version) is listed as comprising 8832 sequences, however, the 558 page document scanned only goes to SEQ ID NO: 3528. Hence, sequences 3529 – 8832 are not presented in the Sequence Listing.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 55, 60, and 66-72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 55 recites “detecting the expression level of a nucleic acid.” Such phraseology is seemingly in conflict. While one may detect the presence or absence of a target (qualitative), one determines the level of expression (quantitative).

9. Claims 60 and 66-72, which depend from said claim 55, fail to overcome this issue and are similarly rejected.

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 55, 60, and 66-72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12. Attention is directed to the decision in *University of Rochester v. G.D. Searle & Co.* 68 USPQ2D 1424 (Fed. Cir. 2004) at 1428:

To satisfy the written-description requirement, the specification must describe every element of the claimed invention in sufficient detail so that one of ordinary skill in the art would recognize that the inventor possessed the claimed invention at the time of filing. *Vas-Cath*, 935 F.3d at 1563; see also *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 [41 USPQ2d 1961] (Fed. Cir. 1997) (patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention”); *In re Gosteli*, 872 F.2d 1008, 1012 [10 USPQ2d 1614] (Fed. Cir. 1989) (“the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed”). Thus, an applicant complies with the written-description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F.3d at 1572.

13. For convenience, claim 55 is reproduced below.

55. (New) A method of diagnosing or monitoring transplant rejection in a patient, comprising detecting the expression level of a nucleic acid in said patient to diagnose or monitor transplant rejection wherein said nucleic acid comprises a nucleotide sequence wherein said nucleotide sequence is selected from the group consisting of SEQ ID NO: 3702, SEQ ID NO: 2073, SEQ ID NO: 213, SEQ ID NO: 3028, SEQ ID NO: 4758, SEQ ID NO: 6299, SEQ ID NO: 832, SEQ ID NO: 2143, SEQ ID NO: 3651, and SEQ ID NO: 3750.

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14. As presently worded, one is to use "a nucleotide sequence" of SEQ ID NO: 4758. Such language has been interpreted as encompassing the full length of SEQ ID NO: 4758 as well as any fragment thereof, wherein said fragment is at least two nucleotides in length. A review of the specification fails to find an adequate written description of where any nucleotide sequence of SEQ ID NO: 4758 has been associated with transplant rejection. Further, the specification has not been found to provide an adequate written description of where expression level of SEQ ID NO: 4658 has been associated with transplant rejection in any animal.

15. It appears that applicant is attempting to satisfy the written description requirement of 35 USC 112, first paragraph, through obviousness. Obviousness, however, cannot be relied upon for satisfaction of the written description requirement. In support of this position, attention is directed to the decision in *University of California v. Eli Lilly and Co.* (Fed. Cir. 1997) 43 USPQ2d at 1405, citing *Lockwood v. American Airlines Inc.* (Fed. Cir. 1997) 41 USPQ2d at 1966:

Recently, we held that a description which renders obvious a claimed invention is not sufficient to satisfy the written description requirement of that invention.

16. For the above reasons, and in the absence of convincing evidence to the contrary, claims 55, 60, and 66-72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-

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0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bradley L. Sisson
Primary Examiner
Art Unit 1634

BLS
01 February 2006